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09/501,874	02/10/2000	Stephen Lange Ranzini	3892-4000	4487

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EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/501,874

Applicant(s)
Ranzini Stephen Lange et al.

Examiner
Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 21, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-187 and 189-193 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-187 and 189-193 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 12
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Examiner Pierre Eddy Elisca
United States Department of Commerce
Patent and Trademark Office
Washington, D.C. 20231

DETAILED ACTION

1. This Office action is in response to Applicant, Response, filed on 10/21/2003.
2. Claims 1-187, and 189-193 are pending.
3. The rejection to claims 1-15, 19-27, 55-61, 73-81, 100-112, 121, 122, 126, 128, 129, 130, 140-149, 155-159, 162-164, 172-174, 177-179, 180-182, 189 and 190-193 under 35 U.S.C. 102 (b) as being anticipated by Bocinsky and to claims 16-18, 28-54, 82-99, 123, 124, 127, 131-139, 150-154, 160, 161, 165-169, 175, and 176 under 35 U.S.C. 103 (a) as being unpatentable over Bocinsky, Jr (U.S. Pat. No. 5,371,797) as set forth in the Office action mailed on 07/21/2003 is maintained. See below.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-15, 19-27, 55-61, 73-81, 100-112, 121, 122, 126, 128, 129, 130, 140-149, 155-159, 162-164, 172-174, 177-179, 180-182, 189 and 190-193 are rejected under 35 U.S.C. 102 (b) as being anticipated by Bocinsky (U.S. Pat. No. 5,371,797).

As per claims 1, 2, 4, 5, 8-15, 19, 20, 22, 23, 26, 27, 55, 56, 58, 59, 121, 122, 129, 130, 140- 144, 162, 163, 164, 189 and 190-193 Bocinsky discloses a secure electronics funds or other financial transaction system that provides substantially equivalent security to that obtained by the use of secure point of sale terminals which is equivalent to Applicant's claimed invention wherein said: a method for securely transferring electronic funds, comprising;

a) assigning at least one security attribute to a digital rights management container containing a digital representation of money, wherein the at least one security attribute precludes unauthorized access to the container containing the digital representation of money, and wherein the at least one sender-defined security attribute is defined at the time of an electronic fund transfer (see., fig 2, elements 30 and 36, abstract, col 11, lines 3-34, col 12, lines 4-34, please note that Applicant's newly added limitation is disclosed in the abstract, specifically wherein it is stated that conducting a transaction, the customer provides the access code, which is unmasked and concatenated with second portion to

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recreate the original full encrypted PIN. This, together with the encryption key used for the original encryption is provided to conventional security and transaction processing apparatus for regional banking networks to seek authorization for the transaction, please note that the process of providing the access code, which is unmasked with second portion to recreate the original full encrypted PIN is readable a security attribute that is defined at the time of the fund transfer);

b) transmitting the container containing a digital representation of money to a recipient (see., abstract, lines 6-26, col 6, lines 6-67). Please note that the security attribute is interpreted as the customer security identification such as PIN number that also includes encryption key, password and so, for monitoring or authorizing data passing from a conventional network or for protecting unauthorized access .

As per claims 3, 21 and 57, Bocinsky discloses the claimed method, wherein the at least one security attribute is the requirement that a recipient of the container containing a digital representation of money enter password, social security number, employee identification number or personal identification number (see., col 4, lines 36-59)

As per claims 6, 24 and 60, Bocinsky discloses the claimed method, wherein the at least one security attribute is the requirement that a recipient of the container containing digital representation of money prove they are the intended recipient through use of a random number generator card or smart card (see., col 5, lines 23-39).

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As per claims 7, 25 and 61, Bocinsky discloses the claimed method, wherein the at least one security attribute is the requirement that a recipient of the container containing a digital representation of money prove they are the intended recipient through biometric scan comprised of a retina scan, fingerprint, voiceprint (see., col 18, lines 48-68).

Claims 73-81, 126, 145-149, 172, 173 and 174 are system's claims that contain the same limitation as claims 1-18, and claim 73, therefore are rejected by the same rationale.

Claim 100-108, 128, 155-159, 177, 178 and 179 are system's claims that contain the same limitation as claims 1-18, therefore are rejected by the same rationale.

Claims 109-112, 180, 181 and 182, contains the same limitation as claim 1, therefore are rejected by the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 62- 72, 113-120, 125, 170, 171 and 183-187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky, Jr. (U.S. Pat. No. 5,371,797).

As per claims 62-72, 113-120, 125, 170, 171, 183, 184, 185, 186 and 187 Bocinsky substantially discloses the claimed limitations as stated above in claims 1 and 13, but he fails to specifically disclose the step of confirming the transfer upon receiving an electronic mail message. However, Examiner hereby takes Official Notice that electronic mail is notoriously well-known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic funds transfer of Bocinsky by including an electronic mail upon receiving the money transfer because electronic mail is an object of the internet.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 16-18, 28-54, 82-99, 123, 124, 127, 131-139, 150-154, 160, 161, 165-169, 175 and 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky, Jr. (U.S. Pat. No. 5,371,797).

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As per claims 16-18, 28-54, 82-99, 123, 124, 127, 131-139, 150-154, 160, 161, 165-169, 175 and 176, Bocinsky substantially discloses the claimed limitations as stated above in claims 1 and 13, but he fails to specifically disclose the step of confirming the transfer upon receiving an electronic mail message. However, Examiner hereby takes Official Notice that electronic mail is notoriously well-known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic funds transfer of Bocinsky by including an electronic mail upon receiving the money transfer because electronic mail is an object of the internet.

Response to Arguments

10. Applicant's arguments filed 10/21/2003 have been fully considered but they are not persuasive.

REMARKS

11. In response to Applicant's arguments, filed on 10/21/2003, Applicant argues that Bocinsky does not teach or suggest:

a. " wherein the at least one sender-defined security attributes is defined at the time of an electronic fund transfer". However, the examiner respectfully disagrees because Bocinsky discloses this limitation in fig 2, elements 30 and 36, abstract, col 11, lines 3-34, col 12, lines 4-34, specifically wherein it is stated that conducting a transaction, the customer provides the access code, which is

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unmasked and concatenated with second portion to recreate the original full encrypted PIN. This, together with the encryption key used for the original encryption is provided to conventional security and transaction processing apparatus for regional banking networks to seek authorization for the transaction, please note that the process of providing the access code, which is unmasked with second portion to recreate the original full encrypted PIN is readable a security attribute that is defined at the time of the fund transfer .

b. “ the alleged definition (PIN) does not occur at the time of a fund transfer”. Based upon the foregoing rejection indicated above, it is believed that the PIN number that also includes encryption key, password (or attribute) and so of Bocinsky is for electronic funds transfer see., title, abstract, col 3, lines 40-67, col 4, lines 1-59.

c. “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggest by the prior art”.

The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or

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legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter); and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

CONCLUSION

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shorted statutory period for reply to this final action is set to expire THREE MONTHS from the mailing data of this action. In the event a first reply is filed within two months of the mailing data of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136 (a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Pierre Eddy Elisca

Primary Examiner

January 05, 2004